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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/397,959

09/17/1999

KARL ERIK STAHL

927.1003

9455

21171

7590

12/26/2006

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

DUONG, DUC T

ART UNIT

PAPER NUMBER

2616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/26/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/397,959	STAHL, KARL ERIK	
	<b>Examiner</b>	<b>Art Unit</b>	
	Duc T. Duong	2616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
       If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
       a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
           1. ☐ Certified copies of the priority documents have been received.  
           2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
           3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
       \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
       a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Mortsof et al (US Patent 6,229,804 B1).

Regarding to claims 1 and 4, Mortsof discloses a telecommunication apparatus 23 for initiating and receiving voice and data calls (fig. 2) comprising a first port (connection from the gateway 23 to the terminal 24) to connect said apparatus 23 to a PSTN network 14' (col. 2 lines 23-28), a second port (connection from the gateway 23 to the Internet 18) to connect said apparatus to a packet-based network 18 (col. 2 lines 23-28), and a gateway means (implicitly shown) for establishing a path (call from terminal 10 to terminal 24) between said first port and said second port inside said apparatus in response to a request from a gatekeeper 20 on the Internet 18 acting on

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behalf a caller 10 (col. 3 lines 23-31), whereby said telecommunication apparatus 23 can serve as part of a distributed gateway system (a distributed gateway system is defined in the specification on page 18, lines 5-7 as a gateway connecting to both the PBDN and the PSTN) between said circuit switched telecommunication network 18 and said packet based telecommunication network 14 (fig. 2; the gateway 23 serve as a distributed gateway system connecting to both the PSTN 14 and the Internet 18).

Regarding to claim 2, Mortsof discloses a third port (connection from the gateway 23 to the terminal 22) to connect a conventional telephone apparatus 22 via said telecommunication apparatus 23 to said first port (fig. 2 col. 2 lines 23-28).

Regarding to claim 5, Mortsof discloses gateway location servers 20 connected to said Internet 18, said gateway location servers 20 being adapted to receive a request from a first telecommunication apparatus 16 connected to said Internet 18 for telecommunication with a specified telephone apparatus 22/24 on said PSTN network 14, and further being programmed to select a second of said telecommunication apparatuses 23 to serve as gateway between said networks for said requested connection, and to forward to said request to said second telecommunication apparatus 23 via Internet 18 (fig. 2 col. 3 lines 11-31).

Regarding to claims 6 and 7, Mortsof discloses the packet based telecommunication network comprises the Internet 18 (fig. 2 col. 2 lines 15-17).

Regarding to claim 8, Mortsof discloses a telecommunication apparatus 23 for initiating and receiving voice and data calls (fig. 2) comprising a first port 242 (connection from the gateway 23 to the terminal 24) to connect said apparatus 23 to a

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PSTN network 14 (col. 2 lines 23-28), a second port (connection from the gateway 23 to the Internet 18) to connect said apparatus 23 to the Internet 18 (col. 2 lines 23-28), and a gateway means (implicitly shown) for establishing a path (call from terminal 10 to terminal 24) between said first port and said second port inside said apparatus in response to a request from the Internet 18 (col. 3 lines 23-31); and gateway location servers 20 connected to said Internet 18, said gateway location servers 20 being adapted to receive a request from a first telecommunication apparatus 16 connected to said Internet 18 for telecommunication with a specified telephone apparatus 24 on said PSTN network 14, and further being programmed to select a second of said telecommunication apparatuses 23 to serve as gateway between said networks for said requested connection, and to forward to said request to said second telecommunication apparatus 23 via Internet 18 (col. 3 lines 11-31), whereby said telecommunication apparatus 23 can serve as part of a distributed gateway system (a distributed gateway system is defined in the specification on page 18, lines 5-7 as a gateway connecting to both the PBDN and the PSTN) between said circuit switched telecommunication network 18 and said packet based telecommunication network 14 (fig. 2; the gateway 23 serve as a distributed gateway system connecting to both the PSTN 14 and Internet 18).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mortsolf in view of Chan et al (U.S. Patent 6,711,160 B2).

Regarding to claim 3, Mortsolf discloses all the limitations with respect to claim 2, except for a mechanism to automatically connect said third port directly to said first port in the event of power failure. However, Chan discloses packet telephone system comprising a fallback switch 110 for connecting a telephone handset 111 (third port) directly to a PSTN interface 112 (first port) in the event of power failure (fig. 1 col. 6 lines 51-64). Thus, it would have been obvious to a person of ordinary skill in the art to employ a fallback switch as taught by Chan in Mortsolf's system to provide an optional arrangement capable of making telephony connection when the packet network is inactive.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mortsolf in view of Bhattacharya et al (US Patent 6,353,610 B1).

Regarding to claim 10, Smith discloses all the limitations with respect to claim 9, except for a means for automatically notifying said gateway location servers when its PSTN connection is Off Hook so it temporarily is not available to serve as a gateway between the packet based network and the circuit switched network. However, Bhattacharya discloses an internet telephony system, wherein a source gateway 100 (gateway location server) is notified of an off hook condition when the destination gateway 130 serving between the Internet 125 and the PSTN 145 detects a busy signal (fig. 1 col. 4 lines 52-61). Thus, it would have been obvious to a person of ordinary skill

in the art to employ an off hook notification as taught by Bhattacharya in Mortsolf's system to alert the subscriber of the connection status.

### ***Response to Arguments***

6. Applicant's arguments filed October 3, 2006 have been fully considered but they are not persuasive. In response to applicant's arguments, the recitation initiating and receiving has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, applicant's argument on page 6 that the apparatus 16 and 23 of Mortsolf are not capable of "initiating or receiving voice and data calls" is traversed. When the gateway 16 or 23 places a call to the called party 22 or 24 (col. 3 lines 23-31), the gateways indeed capable of initiating and receiving voice and data calls as claimed. By definition, the terms "initiating and receiving" in the claims are not distinguishable from the functions of the gateways 16 and 23 placing a call or receiving a call. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., using a single channel gateways in multiple apparatuses) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re*

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*Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Based on the reasons set forth here the rejections are maintained.

***Allowable Subject Matter***

7. Claims 9, 11, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is 571-272-3122. The examiner can normally be reached on M-F (9:00 AM-6:00 PM).

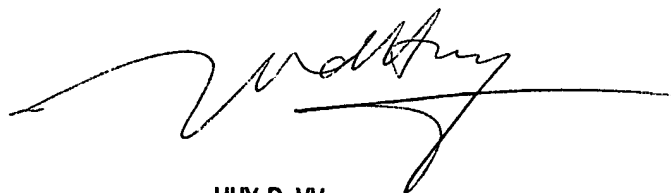


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DD  
DD

A handwritten signature in black ink, appearing to read 'Huy D. Vu', with a long horizontal flourish extending to the right.

HUY D. VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600